

REMARKS

Claims 1 and 23-30 are pending in the current application. No amendments have been made to the claims. Consideration of the remarks herein is respectfully requested.

TELEPHONE INTERVIEW SUMMARY

Applicants would like to thank the examiner for speaking to Applicants' attorney on December 7, 2004. At that time, the claims were discussed, but no agreement was reached.

TERMINAL DISCLAIMER

In response to the nonstatutory double-patenting rejection, Applicants, with this paper, are submitting a terminal disclaimer.

CLAIM REJECTION - 35 USC §102

The Examiner has rejected claims 1, 23 and 27 — 30 under 35 USC Section 102(b) as being anticipated by US Patent Number 5,706,626, granted to Lee Mueller (the Mueller patent).

Prior Art

Applicants respectfully disagree with the basis for the rejection. The Mueller patent cannot be a 102(b) reference against the present application. The effective filing date of the present application precedes the publication of the Mueller patent on January 13, 1998.

Under 35 USC Section 102(b), a granted patent is prior art as of the date it became public, either through patenting, for patents that were not published prior to issuance, or through publication, for those patents that can now be published prior to issuance. The Mueller patent did not become public until January 13, 1998 when it issued. It was filed before the publication provisions of the American Inventors Protection Act went into effect, so it was not published before issuance.

The publication date of the Mueller patent is not more than a year before the filing date of the present application, because the present application is a continuation and claims priority of United States application 08/873,972, now US Patent Number 6,643,986. All claims of the present application have an effective filing date of June 12, 1997.

Applicants respectfully request that the 102(b) rejection be withdrawn.

Anticipation

It is respectfully submitted that the Examiner has failed to set forth a prima facie rejection under 35 U.S.C. §102. The examiner has used the same structure of Mueller to anticipate two structural elements in Applicants' claimed invention. Such a rejection is not consistent with the law of Anticipation.

With the respect to the present application, claims 1 and 23, the independent claims of the application, are the broadest claims. Claims 24 through 30 depend from claim 23.

In order to anticipate claims 1 and 23, the Mueller patent must disclose **both** "...framing members..." **and** "...means for reducing bending of said perimeter fasteners...", arranged in the manner set forth in the claims, including their relationship with respect to the perimeter fasteners and the structural panel.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP §2131). Hence, all of the structural elements called for in the present claims must be shown to be anticipated.

In the rejection, the examiner has cited a group of elements in Mueller -- side posts (102a,b), the horizontal upper member (104), the horizontal lower member (106), and the two

reinforcing members that interconnect the side posts (140) -- as serving as both the “framing members” and the “means for reducing bending” in the present claims. This single group of elements cannot serve as the basis for rejecting two elements defined in the claims. The following chart illustrates the elements of the claims with respect to the rejection:

Claim 1	
b. said plurality of framing members disposed in registration with said proximal side of said structural panel near said edge faces;	“... a plurality of framing members disposed in registry with a proximal side of the structural panel (110a,b)... the framing members (102a,b) (104) (106) (140)...” (<i>Office Action of June 9, 2004, P.3</i>)
d. means for reducing bending of said perimeter fasteners attached to a substantial number of said perimeter fasteners, said means for reducing bending of said perimeter fasteners acting when said lateral forces are imposed on said building structure.	“.... Wherein the framing members (102a,b) (104) (106) (140)... serve as a means for reducing bending... and the bending means (102a,b) (104) (106) (140) having portion (120) on the distal sides such that the fasteners (124) does not extend there-beyond...” (<i>Id.</i>)
Claim 23	
b. a first elongated framing member disposed in registration with said proximal sides of said structural panels near one of said edge faces of each of said structural panels and one or more second elongated framing members disposed in registration with said proximal sides of said structural panels near a different one of said edge faces of each of said structural panels;	“... a plurality of framing members disposed in registry with a proximal side of the structural panel (110a,b)... the framing members (102a,b) (104) (106) (140)...” (<i>Id.</i>)
means for reducing bending of said perimeter fasteners attached to at least several perimeter fasteners of said plurality of perimeter fasteners connecting each of said structural panels to said first elongated framing member, said means for reducing bending of said perimeter fasteners acting when said lateral forces are imposed on said building structure, said means for reducing bending of said perimeter fasteners having portions disposed on said distal sides of said structural panels, and said means for reducing bending of said perimeter fasteners not extending substantially beyond said first elongated framing member.	“.... Wherein the framing members (102a,b) (104) (106) (140)... serve as a means for reducing bending... and the bending means (102a,b) (104) (106) (140) having a portion (120) on the distal sides such that the fasteners (124) does not extend there-beyond...” (<i>Id.</i>)

As the foregoing chart illustrates, the rejection improperly sets forth the same prior art elements against two structural limitations in the claimed invention. Considering all of the limitations of the elements in claims 1 and 23, the side posts (102a,b), the horizontal upper member (104), the horizontal lower member (106), and the two reinforcing members that interconnect the side posts (140) of the Mueller patent cannot serve both as the “framing members” and the “means for reducing bending”.

In addition, the “means for reducing bending of the perimeter fasteners” calls for a structural element. It is not a statement about a function performed by the framing members. This means-plus-function language in claims 1 and 23 specifically describes corresponding structure in the specification that attaches to the perimeter fasteners and interacts with them.

A claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding structure described in the specification and equivalents thereof.” 35 U.S.C. §112, paragraph 6. Key language in the present claims is couched in terms of means-plus-function, as set forth in *In re Donaldson*, 29 USPQ2d 1845, 1848 (Federal Circuit 1994), “[O]ne construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure” *Id.*

Moreover, the USPTO must apply 35 U.S.C. §112, sixth paragraph, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application. See *Donaldson*, 16 F.3d at 1194, 29 USPQ2d at 1850 (MPEP §2181).

Other limitations in the claims further define the structures that reduce the bending of the perimeter fasteners and their arrangement with respect to the perimeter fasteners and the framing members. In particular, the “perimeter fasteners”, as defined in the claims, connect the structural panel to one or more framing members and those framing members are located near the edge faces of the structural panel, and the “means for reducing bending of said perimeter fasteners” are attached to perimeter fasteners.

When all of the limitations of the claims are considered, none of the elements identified by the examiner in Mueller, such as the reinforcing members (140) that interconnect the side posts (102a,b), can be considered to be structurally or functionally equivalent to the claimed “means for reducing bending of the perimeter fasteners”.

Applicants respectfully request that the rejections of claims 1 and 23 be removed, and thereby the rejections of all of the dependent claims as well.

With reference to claims 24, 27, 28, 29 and 30, all of these claims depend from claim 23, and Applicants remarks (with respect to the examiner’s characterization of the elements of the present claims, the examiner’s identification of equivalent structures in the Mueller patent to the framing members and the “means for reducing bending of the perimeter fasteners”, and the examiner’s arrangement of those elements with respect to the structural panel and the perimeter fasteners) are the same as that above and are therefore not repeated.

CLAIM REJECTION - 35 USC §103

The Examiner has rejected claims 25 and 26 under 35 USC §103(a) as being rendered obvious by the Mueller patent..

As noted above, Applicants respectfully disagree with the 35 USC §102(b) basis for the rejection under the Mueller patent.

As noted above, Applicants also believe that the examiner has also failed to show that the Mueller patent supplies all of the elements and the arrangement of those elements with respect to the framing members, the “means for reducing bending of the perimeter fasteners” the structural panel and the perimeter fasteners.

With respect to the examiner’s specific statements about claim 25, and the examiner’s comments with respect to the selection of the spacing of the fasteners, Applicants disagree that the spacing of 2” called for in claim 25 can be rendered obvious in light of the Mueller patent or that the Mueller patent can be used as an example of the knowledge of a person of ordinary skill in the art. The invention described in the Mueller patent was designed to resist lateral forces caused by earthquakes, but fails to teach the specific spacing called for in claim 26.

With respect to the examiner’s statements about claim 26, and the examiner’s comments with respect to the selection of wood as the material for the structural panel, Applicants disagree that this claim can be rendered obvious in light of the Mueller patent or that the Mueller patent can be used as support for characterizing the selection of wood as the material for the panel as an “obvious matter of design choice.” Applicants note that the table in the specification of the present application, at page 19, shows a notable increase in the strength of wood-panel shear walls, when made according to the present invention. In comparison, neither Mueller or the comments by the examiner actually demonstrate that it is desirable to use wood as the material for the panel of a shear wall.

Applicants respectfully request that the rejections of claims 25 and 26 be removed.

CONCLUSION

Applicants believe that the claims are in condition for allowance and request that the examiner allow the application.

If the examiner has any questions with respect to this paper, Applicants' attorney would be happy to discuss them with the examiner.

Respectfully submitted,

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Reg. No. 41,695
Telephone: (510) 832-4111
Facsimile: (510) 832-4115
Customer Number: 498

BY: 
Charles R. Cypher

Law Offices of James R. Cypher
405 - 14th Street, Suite 1607
Oakland, CA 94612-2777